1638

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Gabriel Lopez		June 6, 2005
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J&J-1825

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicants: Kutchan et al — Art Unit: 1638

Serial No.: 09/937,665 — Examiner: B. Koroma

Filed: February 20, 2002

For: CODEINONE REDUCTASE FROM ALKALOID POPPY

Assistant Commissioner for Patents
Washington, D.C. 20231

RESPONSE

Sir:

This is in reply to an Office Action dated May 13, 2005.

The claims are 1-62. The Examiner states that claims 1-58 are pending in the application. The application was filed on September 26, 2001 with 62 claims and with an accompanying Preliminary Amendment which amended some claims but canceled none. Clarification is requested concerning claims 59-62, which the Examiner does not indicate are pending.

The Examiner states that under PCT Rule 13.2 the application lacks unity of invention and requires an election among six groups "to which the claims must be restricted" with a further "selection" of a nucleotide sequence *which is said not to be construed as a requirement for an election of species.* Applicants traverse. This application is a 371 of a PCT application and therefore US Restriction practice does not apply. The Examiner justifies the election by using the unity of invention standard of PCT Rule 13 since this application was filed under 35 USC 371. However, the election standard is being mis-applied by the Examiner since the PCT application from which this application derives has already been examined and deemed not to lack unity of invention. (The Examiner's attention is directed to the IPER, specifically Boxes 3 and V thereof.) It appears that the Examiner has used "unity of invention" language to draft the Action but has, in fact, applied US restriction practice standards, which is impermissible.

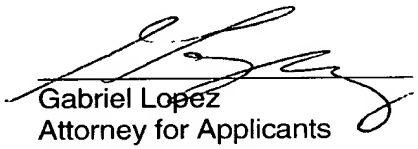
It is requested that the Examiner withdraw the requirement or explain why this 371 application is being held to a different standard than that of the PCT application from which it derived.

The Examiner is also requested to withdraw the requirement since claims 59-62 were not included in the choice of groups.

Further, if the selection of a single sequence is not an election of species, then it is requested that the Examiner explain what it is.

However, solely to preserve their rights, applicants make an election. Applicants elect, with traverse, Group I. Regarding the "selection" of a sequence, clarification is requested for two reasons. First, applicants request that the Examiner provide the statutory or regulatory basis for this request. Second, the Examiner has required that applicants select "from among Figures 1-10". Why applicants are limited to this choice of figures is unclear. The Examiner's attention is directed to the 15 figures in the application and to the description thereof on pages 8-10. Clearly, many of Figures 1-10 do not depict nucleotide sequences and applicants do not appear to be given the opportunity to select from Figures 11-15.

Respectfully submitted,



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Date: June 6, 2005